

separation of the perforations at the top and along one side of said package permits the package to unfold to reveal a printed interior.

18.(New) The data card display package according to claim 17, wherein said window is a diecut window disposed in and bordered on three sides by the front of the package.

REMARKS

The present application was filed pursuant to 35 U.S.C. § 251 as a reissue application of U.S. Patent No. 5,842,629 filed on August 9, 1996 and granted on December 1, 1998. Claims 5, 7-11, 13-16 are herein canceled, claims 17-18 are added, and claims 1-4 of the original patent remain unchanged. Thus, claims 1-4 and 17-18 are pending in the application.

Further consideration and allowance of this application are respectfully requested.

The Examiner objected to the abstract of the disclosure because in lines 1 and 2, there were words misspelled in each line. MPEP § 608.01(b). Accordingly, a new Abstract is provided herewith on a separate sheet of paper with corrected spellings.

The Examiner objected to the disclosure because in the proposed amendment to the specification at page 7, line 17, the last three lines thereof, the word "the" is misspelled twice. Applicant has re-presented the entire text of the subject paragraph to place it in its originally-issued condition. This should eliminate the foregoing problem.

The Examiner maintained his objection to the reissue filing of December 9, 1999 because it introduces new matter into the disclosure. The added material not supported by the original disclosure was cited as including the added paragraphs directed to U.S. Patent Nos. 5,918,909, 5,609,253, 5,427,832, 3,773,2515,294,041 and 5,376,048 on pages 2-4, the reference to "with exemplary dimensions of approximately" at line 11 of page 7, the reference to "approximately" at line 12 of page 8, the change from "generally" to "preferably" at line 15 of page 9, the change from "exposing the magnetic stripe 20" to "thereby leaving the magnetic stripe 20 normally exposed" at lines 14-15 of page 10 and the statement made by the

paragraph added at the end of the original disclosure on pages 11-12. Applicant has deleted the discussion of the prior art patents on pages 2-4, and has re-presented the entire text of each of the other paragraphs to eliminate the added material. This should eliminate the foregoing problem.

The Examiner finally rejected claims 5, 7-11 and 13-14 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 5, 7-11 and 13-14 are herein canceled and replaced by new claims 17-18, which are likewise drawn to the embodiment of Fig. 4. According to the Examiner, the "embodiment" as shown in Figure 4 is not a standalone embodiment, but rather an individual component part of the embodiment of Figures 1-3 separated into constituent parts.

Applicants appreciate the time and consideration given by Examiner Gehman during the interview of June 12, 2001, whereby this issue was discussed. Applicants also confirm the substance of the Interview Summary of the same date in which applicant's agreed to submit a request for reconsideration. Specifically, during said Interview applicants pointed out to the Examiner that the embodiment of Fig. 4 is indeed a standalone embodiment (as supported by the language appearing at column 4, lines 12-16 of the present patent.) As such, it is submitted that new claims 17-18 are directed to subject matter which was adequately described in the specification at the time the application, and that applicant clearly had possession of the claimed invention. With regard to Figures 4 and 5 not including a "transparent layer" as previously claimed, new claim 17 is intended to more closely conform to the original claims and merely recites the display pack having "a window" that permits viewing of the front of the data card. Claim 18 further specifies that "said window is a diecut window". Reference to "transparent" or "cellophane" is omitted and as such the new matter issue should be alleviated. With regard to the Examiner's specific rejection of claim 9 as introducing new matter, this claim is canceled.

The Examiner finally rejected claims 5, 7-11 and 13-14 under 35 U.S.C. 112, second paragraph, as being indefinite because in claim 5, lines 2, 7 and 8, "said data card" lacks clear antecedent basis, as the phrase in line 1, "A data card display package for displaying a data card..." does not positively define a data card as a component, and renders the subsequent reference to "said data card" to be indefinite. Accordingly, the cited claims are herein canceled and new claims 17 and 18 positively recite the data card as an element. This is intended to more closely conform to original claim 1 which does the same.

With regard to the Examiner's specific rejection of claim 11 as per the above, this claim is canceled.

The Examiner finally rejected claims 5, 7-11 and 13-14 under 35 U.S.C. 251 as being an improper recapture of claimed subject matter surrendered in the application for the patent upon which the present reissue is based. (citing Hester Industries, Inc. v. Stein, Inc., 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); In re Clement, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997). According to the Examiner, the record of the application for the patent shows that the broadening aspect (the attempt to claim the embodiment of Fig. 4 in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Therefore, the Examiner considers that the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S. C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application. Indeed, the embodiment of Fig. 4 was never properly claimed during the original pro se prosecution. However, the rules applicable to this reissue procedure do not foreclose applicant's ability to recapture subject matter that was originally disclosed, but that was inadvertently not claimed. Specifically, as stated in the M.P.E.P. at section 1412.01, "*The reissue claims must be for the same invention as that disclosed as being the invention in the original patent, as required by 35 U.S.C. 251. This does not mean that the invention claimed in the reissue must have been claimed in the original patent, although this is evidence that applicants considered it their invention.*" The entire disclosure, not just the claim(s), is

considered in determining what the patentee objectively intended as his or her invention.”

Claims presented in a reissue application are considered to satisfy the requirement of 35 U.S.C. 251 that the claims be "for the invention disclosed in the original patent" where:

(A) the claims presented in the reissue application are described in the original patent specification and enabled by the original patent specification such that 35 U.S.C. 112 first paragraph is satisfied; and

(B) nothing in the original patent specification indicates an intent not to claim the subject matter of the claims presented in the reissue application.

*“Some disclosure (description and enablement) in the original patent should evidence that applicant intended to claim or that applicant considered the material now claimed to be his or her invention.”* (Emphasis added). M.P.E.P. at section 1412.01

Applicant respectfully submits that the subject matter of new claims 17 and 18 (reflected in embodiment of Fig. 4) was manifestly supported and always intended to be a standalone embodiment, as expressly indicated by the language appearing at column 4, lines 12-16 of the original patent which describe it as such. Applicant clearly had possession of the claimed invention, and this embodiment was never claimed and was never surrendered. Moreover, the original patent specification and prosecution history is devoid of anything that would indicate an intent not to claim the subject matter of the new claims 17 and 18 as now presented. In light of the foregoing, then the Examiner’s present grounds for rejection as set forth above were somewhat misplaced, and, applicant’s “mere failure to claim a disclosed embodiment in the original patent (absent an explicit statement in the original patent specification of unsuitability of the embodiment) would not be grounds for prohibiting a claim to that embodiment in the reissue.” M.P.E.P. Section 1412.01.

It is noteworthy that the original reissue oath filed pursuant to 37 C.F.R. 1.175 did specify that applicant initiated the present proceeding by reason of a defective specification in which the patentee claimed more or less than he had the right to claim in the patent, specifically that “The patentees claimed less than they had the right to claim in the



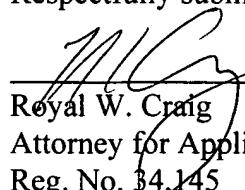
Application Number: 09/458,132  
Sprague, William R., et al.  
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patent...[and] included unnecessary limitations directed to the material of which the package is made, the manner in which it is imprinted, *the presence of perforations...*" The new claims 17 and 18 are intended to eliminate an unnecessary limitation, namely, the presence of perforations along the bottom of the card (which are not present in the embodiment of Fig. 4). Thus the original reissue oath is believed to be sufficient. However, applicant's are not opposed to submitting a substitute declaration if the Examiner is so inclined, and invite the Examiner to contact the undersigned if such is deemed necessary.

\* \* \* \* \*

In view of the above amendments and remarks, it is believed that this reissue application is now in condition for allowance, and such a Notice is respectfully requested.

Respectfully submitted,

  
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## APPENDIX A: REDLINE SPECIFICATION

### VERI MAG PACK

#### BACKGROUND OF THE INVENTION

##### 1. Field of the invention

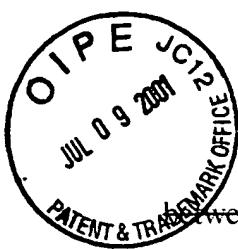
This invention relates to the improved design, construction, and security of packaging for a data card with an encoded magnetic stripe ("data card"), such as a telephone card, that provides security for the encoded data and a printed Personal Identification Number (PIN), a quick release feature to expedite point of purchase processing, packaging with a front and back plus a large area inside the package for printed telephone rate information, instructions for use, or advertisements, as applicable, and an economical way to print this information.

##### 2. Description of the Background

There are limited data card holders that secure a magnetic stripe card to a cardholder backing, blister pack, inserted in envelopes, etc., but they do not protect the data card with a magnetic stripe in a secure pocket and still provide a simplified quick release feature that retains the data card in the packet while exposing only the magnetic stripe (and not the PIN). This feature permits the sales clerk to swipe the card through a magnetic reader to verify, activate, and register the PIN, while still maintaining the integrity of the packet.

Without admitting the prior art value of the same, U.S. Patent No. 5,918,909 to Fiala derives from an earlier filed application (now abandoned) that shows a data card sandwiched

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~~between opposing panels and riveted therein. Aside from the present invention, the Fiala '909 patent is the earliest known attempt at a package that permits swiping of the protruding card through a magnetic reader without destroying the integrity of the packet.~~

— U.S. Patent number 5,609,253 to Goadé discloses a data card security display packaging  
5 for the security of the encoded data and PIN on the back of a data card. The Goadé '253 packaging is piecee of card stock with a continuous laminate covering the data card.

Unfortunately, the Goadé '253 packaging has to be substantially destroyed, as Goadé describes, to gain access to the magnetic stripe and PIN on the back of the data card. After the package is destroyed the data card has to be removed to be passed through the magnetic reader.

10 Consequently, the magnetic stripe and PIN are exposed to the retail sales clerk, thereby compromising the security of the PIN printed on the back of the data card. Further, printing is much more constrained. There is no provision for printing text on the interior of the Goadé '253 packaging, and two passes of a printing press are required to print the front and back of the packaging.

15 — U.S. Patent No. 5,427,832 to Longtin shows a continuous business form with a data card in a pocket. The Longtin '832 package is designed for residential mailing rather than retail sales packaging. Again, the packaging must be substantially destroyed to gain access to the magnetic stripe on the back of a data card, thereby compromising the security of the PIN. Moreover, the Longtin '832 reference has no display window for displaying the card itself.

20 — U.S. Patent number 3,773,251 to Hadick likewise shows packaging must be opened to reveal the magnetic stripe, not only destroying the integrity of the paekaging, but compromising the confidentiality of the printed PIN at the retail location.

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U.S. Patent Nos. 5,294,041 and 5,376,048 are continuous feed mailers designed to send

confidential data on a form hidden by a perforated cover. These are mailers that are unsuitable for retail sales display. The packaging must be substantially destroyed to gain access to the magnetic stripe on the back of a data card, thereby compromising the security of the PIN.

5 Moreover, there is no display window for displaying the card itself.

It would be greatly advantageous to provide a retail package design for data cards that allows the data card to remain secured in the packaging when passed through a magnetic reader, thereby maintaining the integrity of the pack and keeping the printed PIN hidden. It would also be advantageous to provide a design layout that increases the available print area for printing rate information, instructions for use, marketing data, or advertisements, as applicable, and yet facilitates printing in one pass of a printing press thus saving the manufacturer money.

#### SUMMARY OF THE INVENTION

Pilferage of the confidential PIN on the back of a data card is one of the most serious problems in data card retail sales. The primary object of our invention is to provide packaging that will protect the security and confidentiality of encoded data on a magnetic stripe and PIN on the back of a data card and provide immediate simple access to the magnetic stripe by a retail sales clerk without damaging the integrity of the packaging or exposing the PIN printed on the back of the data card. Our invention, titled the Veri Mag Pack (VMP or "the pack"), is a Verification Magnetic Stripe Pack that accomplishes this purpose. The VMP includes a data card glued inside a transparent cellophane window on the lower portion of the pack. The magnetic stripe is kept secure until the quick release feature is used. The bottom perforated portion of the data card pack is removed exposing the magnetic stripe portion of the data card but

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the printed PIN, and the data card remains glued to the pack. A retail sales clerk can then pass the magnetic stripe on the data card, that is still attached to the pack, through a magnetic reader at the point of purchase, validating and activating the encoded data and the PIN, without access to the printed PIN. The pack is sold to a customer who is the only one who can access the  
5 printed PIN without destroying the packaging. The purchaser removes the top and side perforated edges from the VMP, and folds it open like a book exposing the PIN printed on the top portion of the back of the data card, and telephone rate information, instructions for use, or advertisements, as applicable, printed on the inside of the pack.

Further objects of our invention are to provide a data card packaging design that can be  
10 printed economically and to provide a substantial area inside the packaging for printing of text materials, such as telephone rate information, instructions for use, or advertisements,  
applicable.

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#### BRIEF DESCRIPTION OF THE DRAWINGS

15 FIG. 1 is a drawing of the 11" x 7.5" ten to twenty point one-piece opaque board packaging that when folded, becomes the front and back sides of our 5.5" x 7.5" packaging invention, titled the Veri Mag Pack (VMP or "the pack"). At the top of the pack is a diecut hanger hole for retail sales display. A 3.375"x2.125" diecut transparent cellophane window is designed to display and hold a data card.

20 FIG. 2 is the completed front view of the Veri Mag Pack. It is now folded and sealed (glued) and perforated to form the completed pack. The figure shows a diecut hanger hole for retail sales display at the top and a diecut transparent cellophane window designed to hold a data card at the bottom. The perforation at the bottom is to allow quick access to the magnetic stripe



does not reveal the PIN. The top and side perforations are provided so that the pack can fold open like a book giving the purchaser easy access to the PIN printed on the upper portion of the back side of the data card, and a list of telephone rate information, instructions for use, or advertisements, as applicable, printed on the inside of the pack.

5 FIG. 3 is a completed back view of the Veri Mag Pack. It shows the diecut hanger hole, the perforated edges and bottom perforations of the pack for easy access to the data card magnetic stripe and printed material.

FIG. 4 is a cut-away front view of the Veri Mag Pack. In this view, one-half of the front of the data card is exposed. The data card remains glued to the upper portion of the pack  
10 protecting the PIN when the bottom perforation is removed thus maintaining the integrity of the pack.

FIG. 5 is a cut-away back view of the Veri Mag Pack. It shows the bottom portion of the back side of the data card with the magnetic stripe exposed. In this position, the magnetic stripe is passed through a magnetic reader to verify and activate the PIN. The PIN printed on the top  
15 portion of the back side of the data card remains hidden. The data card remains securely attached to the upper portion of the pack with adhesive maintaining the integrity of the pack. It also shows the diecut hanger hole and the top and side perforated edges.

FIG. 6 is the inside view of the Veri Mag Pack, which measures 10.25" x 5.5" after the top and side perforated edges and the data card are removed by the purchaser. This provides an  
20 area that can be used by the manufacturer to print telephone rate information, instructions for use or advertisements, as applicable.

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FIG. 7 is the bottom, 5.5" x 2", quick release, disposable portion of the Veri Mag Pack with the diecut transparent cellophane window attached, which when removed, exposes the bottom half of the data card and the magnetic stripe.

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## DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENTS

FIG. 1 is an illustration of a ten to twenty point one-piece opaque paper board packaging 10 (with exemplary dimensions of approximately 7.5" x 11") from which the ~~Veri~~ <sup>VERI</sup> Mag Pack ~~VMP~~ (VMP or "the pack") 30 is constructed with a first side (exterior) 11 and a second side (interior) 12 (not shown), length 13, and width 14. When folded in half along folding points 15 and glued, the packaging 10 becomes the finalized VMP 30 (see FIG. 2). Specifically, the right side of the packaging 10 becomes the front side 31 and the left side becomes the back side 32 of the VMP 30 with a length 13 and width 33 (7.5" x 5.5").

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FIG. 2 shows the front side 31 and FIG. 3 shows the back side 32 of the VMP 30. An aperture comprising a diecut window is formed in the front side 31, and a transparent cellophane layer is glued across the window to form a transparent cellophane window 16 covering a data card 17. The data card 17 is of the type having a front side 18, back side 19, magnetic stripe 20, length 21, width 22 (see FIG. 4 and FIG. 5). In the illustrated embodiment, perforations are shown on three sides of the packaging 10, including top side perforation 23, right side perforation 24, and bottom perforation 25, all to facilitate quick access to the data card 17 and the printed information on the inside of the VMP 30. The quick release of the bottom 25 perforated area of the VMP 30 reveals the magnetic stripe 20 on the bottom half of the back of

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the data card 17 that a retail sales clerk can pass through a magnetic reader at the point of purchase and electronically verify and activate the encoded data and PIN 39 (see FIG. 4 and FIG.5) on the data card 17. The PIN 39 on the data card is not valid until verified and activated thus increasing and protecting the security of the encoded data until purchased. The PIN 39 is not seen by anyone between manufacture and purchase, until a purchaser opens the packaging. When all the perforations ~~perforated areas defined by~~ top side perforation 23, right side perforation 24, and bottom side perforation 25 of the VMP 30 are removed, the pack opens like a book (see FIG. 6) releasing the data card 17 and displaying an area of approximately 7.5" x 11" available for printed text such as telephone rate information, instructions for use, or advertisements ~~applicable~~ to the data card 17.

In addition to the above-described advantages, the one-piece paperboard construction of  
the VMP packaging 10 permits the four-color printing of the entire first side (exterior) 11 (the  
actual front side 31 and back side 32 of the completed VMP 30 as described above) in one single  
pass of a printing press rather than the two separate passes required to print a two-piece exterior  
package resulting in savings for the manufacturer of the VMP. The same savings is realized  
when printing the second side (interior) 12 of the VMP (see FIG. 7). This interior, with an area  
of 7.5" x 11" available for printed text as described above, can also be printed in one pass of a  
printing press instead of the two separate passes required to print a two-piece interior package.

The diecut hanger hole 26 at the top of the packaging 10 and VMP 30 is provided for the display of the pack at a retail location.

FIG. 2 shows the completed VMP 30 with a front side 31 and a back side 32, a length 13 and width 33, interior glue spots, top side 34, right side 35, and bottom 36 that seals the front



side 31 and back side 32 of the VMP 30 by sandwiching the data card 17 and the diecut transparent cellophane window 16 to the opaque interior of the VMP protecting, yet permitting the exposure of the front side 18 of, the data card 17 that is sandwiched between the diecut transparent cellophane window on the front side 31 and back side 32 of the VMP 30.

5 Perforations on the top side 23, right side 24, and bottom 25 permit quick opening of the VMP for easy access to the data card 17. The bottom 25 perforation is removed to gain access to the magnetic stripe 20 for passing through a magnetic reader for immediate verification and activation of the encoded data and PIN 39 (see FIG. 4 and FIG. 5). The front side 31 of the VMP  
30 as shown in this figure is ~~preferably~~<sup>generally</sup> printed with a multi-color company logo,  
10 graphics, or advertising information.

FIG. 3 shows the back side 32 of the completed VMP 30 with a length 13, width 33, and diecut hanger hole 26 at the top of the pack. The back side 32 is made of opaque paper board that completely covers the back 19 of the data card 17 that is sandwiched in the middle of the VMP 30 thus protecting the security of  
15 the encoded data on the magnetic stripe 20 and PIN 39 on the back 19 of the data card 17 while permitting a view of the front side 18 of the data card 17 through the diecut transparent cellophane window 16 for advertising purposes. Thus the printed PIN 39 cannot be read unless the perforated areas are removed, which would result in a damaged package, and if the PIN 39 was exposed, the data card could not be used because the PIN 39 would not have been verified or  
20 activated. This a significant improvement in the security of the PIN 39 not found in similar packaging. The PIN is not viewed by any individual from manufacture of the pack until the packaging is opened by the purchaser.

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FIG. 4 shows the front side 31 of the VMP 30, length 13, width 33, with the bottom 25 perforated area removed, diecut hanger hole 26, perforated top 23, right side 24, with one-half of the front side 18 of the data card 17 exposed. The magnetic stripe 20 is located on the back side 19 of the data card 17 (see FIG. 5). In this configuration, the data card 17 is ready to pass through the magnetic reader for verification and activation of the encoded data and PIN 39. In an alternate embodiment of the invention, the VMP 30 is manufactured in this configuration without the bottom 25 perforated portion, thereby leaving ~~exposing~~ the magnetic stripe 20 normally exposed to further expedite point of purchase processing while protecting the integrity of the PIN 39.

FIG. 5 shows the back side 32 of the VMP 30, length 13, width 33, with the bottom 25 perforated portion removed, putting the magnetic stripe 20 of data card 17 in a position to be passed through a magnetic reader for verification and activation of the encoded data and PIN 39. The perforations at the top 23 and right side 24 are sealed but when removed expose the entire data card 17 and telephone rate information, instructions for use, or advertisements on the second side (interior) 12 of the VMP 30. One of the glue strips 37 that adheres the data card 17 to the second side (interior) 12 of the pack is also shown. A diecut hanger hole 26 is provided for retail display purposes.

FIG. 6 illustrates the second side (interior) 12 of the packaging 10 of the VMP 30, length 13, width 14, with a diecut transparent cellophane window 16 removed. The VMP 30 with 20 perforations, top side 23, right side 24, and bottom 25 removed and unfolded like a book at folding point 15 revealing the second side (interior) 12 that is also the interior of the VMP 30 with an area of 7.5" x 11" available for printed text, such as telephone rate information, instructions for use, or advertisements, as applicable. The bottom 25 perforated portion and data

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17 are removed. The entire one-piece second side (interior) 12 is economically printed in one pass of a printing press instead of the two separate passes required to print a two-piece interior package. Most similar packaging does not provide such a large area, if any, for printed advertising and instructional information. This is a significant improvement in data card  
5 packaging.

FIG. 7 shows the bottom 25 perforated two-inch portion 29 of the VMP 30 with a diecut transparent cellophane window 16 after it is detached from the VMP 30 and a glue strip 28 that helps hold the front side 31 and back side 32 of VMP 30 together and secures and seals the data card 17 to protect the encoded data.

10 ————— Having now fully set forth the preferred embodiments and certain modifications of the concept underlying the present invention, various other embodiments of the invention as well as certain variations and modifications thereto may obviously occur to those skilled in the art upon becoming familiar with said underlying concept. It is to be understood, therefore, that the invention may be practiced otherwise than as specifically set forth herein.

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